

**REMARKS**

Applicants affirm the election to prosecute the invention of Group I, claims 1-20, 25-31 and 38-40. Furthermore, the election of the third compound in claim 25 on page 178 as the "core structure" is similarly affirmed. Claims 21-24 and 32-37 have been canceled as being drawn to a non-elected invention. Applicants reserve the right to further prosecute the subject matter of these claims in a continuing application since they are not being abandoned.

Although not objected to, claim 2 has been amended to correct an inadvertent editorial error in that the word "or" was left out of the claim in the recitation of alternative groups. Entry of the amendment is respectfully requested.

Claims 30, 33, 39-40, 51-60 and 63 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. These claims have been amended pursuant to the Examiner's remarks appearing on page 6 of the Official Action. Specifically, in claims 33 and 63, the phrase "still additionally" has been replaced by the word "further" so that the awkward phrase has been replaced by "further containing." As suggested by the Examiner, claims 30, 39-40 and 51-60 have been amended so that, prior to the first use of the abbreviation "HCV," there is the phrase "hepatitis C virus." While the abbreviation can be clearly understood from the whole of the application, the amendment is offered as a convenience to the reader. Entry of the amendments is respectfully requested. Withdrawal of the rejection of these claims under 35 U.S.C. § 112, second paragraph, is respectfully requested in view of these amendments.

Claim 30 has been amended pursuant to the rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101; entry of the amendment is respectfully requested. The Examiner states that claim 30 provides for the use of a pharmaceutical composition, but the claim does not set forth any steps involved in a method or process. Furthermore, the Examiner states that insofar as the claim is a composition claim, the recited process does not *per se* modify the composition and therefore has no patentable weight. This rejection is traversed.

Claim 30 has been amended to include the word "suitable," which results in the phrase "suitable for." Consequently, the amendment introduces a limitation that requires the claimed compositions to "so perform" or not meet the terms of the claim. Therefore, the phrase constitutes a patentable limitation. In this regard, the Examiner's attention is invited to the decision in *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 9890, 54 U.S.P.Q.2d 1227 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001). In that case, the patent's 41 claims to gasoline compositions that reduced automobile tail pipe emissions were held not anticipated by prior art specialty fuel compositions, such as racing and aviation fuels. All of the claims began with either the phrase "[a]n unleaded gasoline *suitable for* combustion in an automotive engine" (emphasis added) or the phrase "[a]n unleaded gasoline fuel *suitable for* combustion in a spark ignition automotive engine" (emphasis added). The Federal Circuit held that the district court correctly interpreted the claims as limited to "mass market automotive gasoline." In other words, contrary to the Examiner's view in the present application, the phrase "suitable for" was interpreted in the context of the claim as

having patentable significance in conjunction with the other terms of the claim. Respectfully, the same circumstances apply herein. Additionally, in *In re Watson*, 517 F.2d 465(1), 476(2)-477, 186 U.S.P.Q. 11(3), 20 (C.C.P.A. 1975), the court concluded that the claim phrase "an effective amount of a germicide *suitable for* use in oral hygiene" is not indefinite. *Id.* (emphasis added). Although the court directed its attention to the amount of a germicide, there was no objection to the use of the phrase "suitable for" in the claim. Withdrawal of this rejection is respectfully requested.

Claims 42 and 63 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that in claims 42 and 63, "PEG" needs to be spelled out in the first instance of use. Applicants have amended the claims to recite the meaning for the abbreviation PEG as it is understood by one skilled in the art in view of the disclosure in the application. Applicants refer to "PEG-interferon alpha conjugates" as interferon alpha molecules covalently attached to a "PEG" molecule. (The Examiner's attention is invited to page 92 at lines 5-8.) Furthermore, Applicants provide illustrative examples of such materials identified by trade names in the remainder of the identified paragraph. These materials are understood by those skilled in the art to represent the result of a process that attaches a polyethylene glycol (commonly known as PEG) molecule to a compound as recited, and are therefore known in the art as "pegylated" compounds. Entry of the amendment and withdrawal of this rejection is respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 00/05245, *Brunk et al.* (hereinafter

"Brunk"). The Examiner relies on the disclosures at page 33, line 12 to page 43, line 7 and claim 1, pages 159-167 to construct the chemical structure shown in the Official Action at page 8. The Examiner then recites several of the generic components in claim 1 and claim 2 of the present application and selects various specific components for these generic components in order to arrive at the illustrated structure noted above. It is noted that although the Examiner comments that R<sup>5</sup> may be "OH", the illustrated structure shows R<sup>5</sup> as "H."

The disclosures of *Brunk* referred to in the Office Action are generic disclosures, not disclosures of specific compounds allegedly within the scope of instant claims 1 and 2. However, such picking and choosing is not appropriate in a 35 U.S.C. § 102 analysis. See, e.g.:

"Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the 'prior art'" ". . . the [r]eference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings in the cited references. Such picking and choosing may be entirely proper when making a rejection of a 103, obviousness rejection, where the applicant must be afforded opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior but it has no place in the making of a 102, anticipation rejection." (emphasis original). *In re Arkey, Eardly, and Long*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Overlap of the genus taught in the reference and the genus of instant claims 1 and 2 is not sufficient to establish anticipation. Furthermore, *Brunk* is directed to subject matter that differs significantly from that of the present invention; specifically, compounds that inhibit blood vessel formation, whereas the presently claimed compounds treat hepatitis C virus. Consequently, there is no motivation in *Brunk* to make the selections suggested by the Examiner to arrive at the allegedly overlapping compounds, absent Applicants' own teachings. It is respectfully suggested that the rejection is incorrect and should be withdrawn.

However, the dehydropropyl-containing compounds shown on pages 115 and 144-146 of the reference do appear to be within the scope of instant claims 1 and/or 2. Consequently, claim 1 has been amended to exclude these compounds from the scope of the instant claims by amending the recitation in the definition of generic component A to delete the recitation of "a bond." Withdrawal of this rejection and allowance of these claims is respectfully requested in view of the amendment and remarks.

The allowance of claims 61 and 62 is noted.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 09/908,955

Docket No.: SCHERING 3.0-122

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: March 22, 2004

Respectfully submitted,

By 

Harvey L. Cohen

Registration No.: 28,365

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

LD-447\  
479239\_1.DOC